

Appl. No. 10/567,571
Amdt. dated May 1, 2009
Reply to Final Office action of March 23, 2009

REMARKS

Claims 8-13 and 20-24 are presently in the application. Claims 1-7, 14-19 and 25-27 have been canceled.

The examiner has indicated that the reference identified as "US 2003/00715154" has not been considered, because no such document exists. The examiner is correct. The correct document number is US 2003/0075154. However, US 2003/0075154 is prior art which was cited in a Search Report for the International Application which ultimately translated under 35 U.S.C. 371 into this U.S. application.

MPEP 1893.03(g) reads, in part, as follows:

The examiner will consider the documents cited in the international search report, without any further action by applicant under 37 CFR 1.97 and 1.98, when both the international search report and copies of the documents are indicated to be present in the national stage file. The examiner will note the consideration in the first Office action.

MPEP 609.03(g) reads, in part, as follows:

The examiner will consider the documents cited in the international search report in a PCT national stage application when the Form PCT/DO/EO/903 indicates that both the international search report and the copies of the documents are present in the national stage file. In such a case, the examiner should consider the documents from the international search report and indicate by a statement in the first Office action that the information has been considered. There is no requirement that the examiner list the documents on a PTO-892 form.

In a national stage application, the following form paragraphs may be used where appropriate to notify applicant regarding references listed in the search report of the international application:

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*6.53 References Considered in 37 U.S.C. 371 Application
Based Upon Search Report - Prior to Allowance*

The references cited in the Search Report [1] have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO/SB/08A and 08B form, must be filed within the set period for reply to this Office action.

Thus, MPEP 1893.03(g) and 609.03 inform examiners and the public that the examiner **must** consider documents cited in the international search report, without any further action by applicant, when both the international search report and copies of the documents are indicated to be present in the national stage file and that the examiner **must** note the consideration in the first Office action.

The IFW available in PAIRS indicates that both the international search report and copies of the documents cited in the international search report were present in the file at the time of the first Office action. Therefore, the examiner should have noted the consideration of US 2003/0075154 and any other documents cited in the international search report in the first Office action. The examiner is respectfully reminded of this obligation.

Applicants are submitting with this amendment a new PTO/SB/08A correctly identifying US 2003/0075154 and requesting that it be printed on the bibliographic page of any patent issuing from this application, as required by Form Paragraph 6.53 found in MPEP 609.03. The examiner's indication, as required by the MPEP in the next Office action, that the document has been considered would be appreciated.

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The examiner has indicated that claims 10-13 are directed to allowable subject matter, but objected to the claims as dependent on a rejected claim. Claim 10 has now been be rewritten in independent form, including all of the limitations of its parent claim. Accordingly, claims 10-13 are now in allowable condition.

It is also pointed out that claims 21-24 are dependent from claims 10-13 and should also be allowable.

Claim 20 has not been rejected over the prior art. Accordingly, claim 20 has been rewritten in independent form. Claim 20 is now in allowable condition. However, if the examiner intended to reject claim 20 on prior art, the examiner must withdraw the finality of the most recent Office action.

Claims “8-“ stand rejected under 35 U.S.C. 112, second paragraph, as indefinite. It is presumed that the examiner meant to identify claims 8-13 and 20-27 as indefinite, but no reasons for rejecting claims 8-13 are set forth in the “Detailed Action.”

With regard to claims 20-24, the examiner finds that the language “the second valve element” lacks a proper antecedent. The examiner is incorrect. The antecedent is found in claim 8, line 2, which recites “first and second valve elements” (“8. **(Previously presented)** In a fuel injection device for an internal combustion engine with direct fuel injection, the injection device having **first and second valve elements . . .**”). See, also, claim 8, lines 4 and 5 (“ . . . and of which **the second valve element** is coaxially disposed . . .”).

With regard to claims 25-27, these claims depend from canceled claims 14-16 and were intended to be canceled in the previous amendment. The claims have now been canceled.

Claims 8 and 9 stand rejected under 35 U.S.C. 102(b) as anticipated by Kuegler (WO 03/054374). The examiner uses Kuegler (US 6,896,208) for an understanding of Kuegler (WO 03/054374). Reconsideration of the rejection is requested.

Claim 8 requires, inter alia, "the second valve element is coaxially disposed in a longitudinal bore provided in the first valve element and has a hydraulic control face, acting in the closing direction, which defines a **hydraulic control chamber that communicates at least from time to time with a high-pressure connection.**"

The examiner reads the claimed "second valve element" on element 128, the "hydraulic control face" on element 62, and the "high-pressure connection" on Kuegler's pump work chamber 22 and feed pump 64 (see, Final Rejection, p. 3, last line).

Claim 8 also recites "wherein the injector device comprising an additional valve device, which in a **first terminal position** connects the pressure chamber with only the low-pressure connection and **connects the control chamber only with the high-pressure connection.**"

The examiner finds that Kuegler teaches an "additional valve device 72" having a first position (valve 72 is open) where passage 48 is connected to the low-pressure region 78.

Kuegler's valve 72 does not connect the "control chamber" 60 to the high-pressure connection 22 or 64. The "control chamber" 60 is never connected to the pump chamber 22 and is always open or connected to the feed pump 64 regardless of the position of the valve 72. In Kuegler, the valve 72 has nothing to do with the connection between the feed pump 64 and the chamber 60.

Further, claim 8 recites “an additional valve device, which . . . in a **second terminal position** connects the pressure chamber at least predominantly with the high-pressure connection **and substantially disconnects at least one region of the control chamber from the high-pressure connection.**”

The examiner finds that Kuegler teaches an “additional valve device 72” having a second position (valve 72 is closed) where pressure chamber 40 is connected to high-pressure connection 22 and disconnects at least one region 77 of the control chamber 60 from the high-pressure connection 22, 64.

However, the “at least one region” 77 identified by the examiner is not a region of the “control chamber” 60 as required by the language of claim 8. In fact, the region 77 is always sealed off from the “control chamber” 60. If it were not, the control chamber 60 would always be connected to low-pressure region 78 via region 77. To the contrary, Kuegler teaches at col. 3, ll. 53-61 that:

The pressure in the control pressure chamber 60 is adjusted variably as a function of engine operating conditions, such as rpm, load, temperature, and others. To that end, the feed pump 64 can be operated accordingly with a variable rpm, or between the feed pump 64 and the control pressure chamber 60 a relief valve 66 can be provided, by means of which the pressure in the control pressure chamber 60 is controlled; that is, the relief valve 66 opens or closes a communication with a low-pressure region.

Obviously, the pressure in chamber 60 could not be adjusted variably as a function of engine operating conditions and the relief valve 66 would be unnecessary, if, as suggested by the examiner, the region 77 (which is always connected to the low-pressure region 78) is a part or “region” of the control chamber 60.

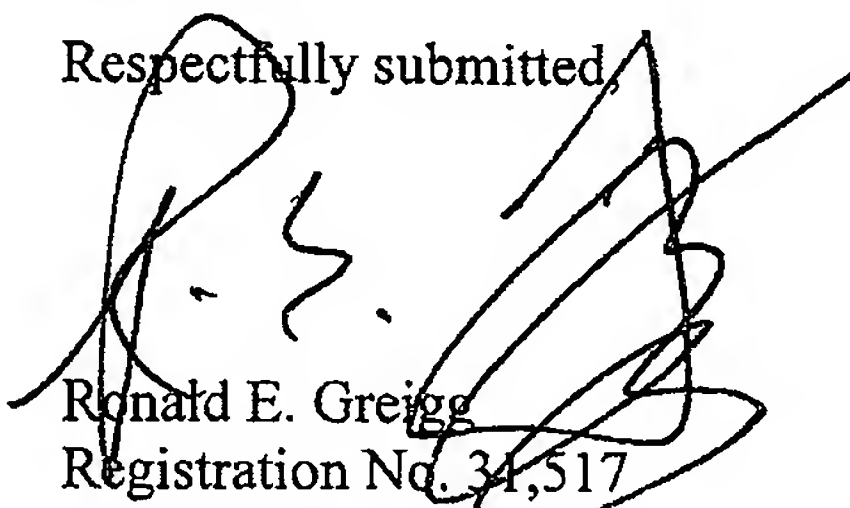
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Further, according to Kuegler (US 6,896,208), col. 4, ll. 26-29, the annular chamber 77 communicates with a low-pressure region, which by way of example may be a return line 78 into fuel tank 24. Thereby, independent of the position of the control valve member 72, the annular chamber 77 is always connected with the low-pressure region. This is also shown in Figs. 1 and 3 of Kuegler. Therefore, even if the region 77 could be described as a "region of the control chamber 60," it would always be connected with the low-pressure connection 78 independent of the position of the control valve 72. Thus, the examiner's finding that Kuegler teaches an "additional valve device 72" having a second position (valve 72 is closed) which disconnects at least one region 77 of the control chamber 60 from the high-pressure connection 22, 64 is clearly erroneous.

The Commissioner is hereby authorized to charge any necessary fees in connection with this communication to Deposit Account Number 07-2100.

Entry of the amendment and allowance of the application are respectfully requested.

Respectfully submitted,


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